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OFFICE OF PETITIONS

In re Application of Kovalic et al.	:	
Application No. 10/767,701	:	Decision Dismissing Petition
Filing Date: January 29, 2004	:	Under 37 CFR 1.78(a)(3)
Attorney Docket No. 16517.311	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 24, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above. The amendment is not acceptable as drafted since it improperly incorporates by reference prior-filed applications.

The amendment adds the following statement to the beginning of the specification,

This application is also a continuation in part of U.S. Application Serial No. 10/425,115, filed April 28, 2003, which is a continuation-in-part of U.S. Application Serial No. 09/985,678, filed November 5, 2001, which is a continuation of U.S. Application Serial No. 09/304,517, filed May 6, 1999.

Page 41 of the specification states, "All publications and patent applications cited herein are hereby incorporated by reference."

One cannot incorporate by reference applications or other matter after an application's filing date because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). *See Dart Industries v. Banner*, 636 F.2d 684, 207 U.S.P.Q. 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

The claims for priority may be made in an Application Data Sheet in compliance with 37 CFR 1.121 and 37 CFR 1.76(b)(5).¹ The Office notes submission of the priority claims via an Application Data Sheet would avoid the incorporation by reference raised by adding the claims to the specification.

Before the petition under 37 CFR §§ 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Steven Brantley at (571) 272-3203.



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¹ 37 CFR 1.76(b)(5) states,

Providing [domestic priority] information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5), and need not otherwise be made part of the specification.